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Attorney Docket No. 1247 P 179  
Application No. 09/713,163  
Page 2

Remarks

Claims 1-58 are pending in this Application, with claims 22-32, 39-46, 48 and 50-58 being allowed. By this Amendment, no claims have been amended, canceled, or added. As a result, claims 1-58 are at issue in this Application.

CLAIM REJECTIONS - 35 U.S.C. §102

In paragraph two of the Office Action, claims 1-3, 13, 17-19, 21, 33, 34, 47, and 49 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,400,026 to Brown ("Brown"). Applicants respectfully traverse this rejection.

The factual determination of anticipation requires the disclosure in a single reference of every element of the claimed invention. *Ex Parte Levy*, 1990 Pat. App. LEXIS 18, \*3, 17 U.S.P.Q. 2d 1461 (BPAI 1990) ("it is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference."); *In re Lange*, 209 U.S.P.Q. 288 (CCPA 1981) (in order to anticipate, the reference must describe or disclose all of the limitations of the claims). It is well-settled law that the burden of establishing a prima facie case of anticipation resides with the Patent & Trademark Office. *Ex Parte Skinner*, 1986 Pat. App. LEXIS 4, 2 U.S.P.Q. 2d 1788 (BPAI 1986).

Independent claim 1 is directed to a tilt-latch for a sash window disposed within opposed guide rails on a master frame and requires, among other things, a housing adapted to be supported by the top rail, the housing having an outward end opening and a cover; a latch bolt disposed within

Attorney Docket No. 1247 P 179  
 Application No. 09/713,163  
 Page 3

the housing and having a nose adapted for engaging a respective one of the guide rails; and, an actuator connected to the latch bolt and sized to be positioned over the entire cover.

Brown is directed to a tilt-latch 20 for a sash window and includes a base member 26, a slide member or bolt 28, and a spring 30 for biasing the bolt 28. As shown in FIGS. 2-4, the bolt 28 has a nose 34 and an upward projection or actuator 78. A pair of projections 80, 82 depend from a lower surface of the base member 26 and are used "...in stabilizing and/or securing the base member on a sash." (Col. 6, lns. 5-10). Referring to FIG. 6, a fastener 84 extends through the projection 80 to secure the base member 26 to the top rail 22 of the window sash.

Applicants submit that the Examiner has not established the prima facie case of anticipation because Brown does not disclose each and every element of independent claim 1. Specifically, Brown does not disclose or suggest independent claim 1's requirement of a housing having a cover. (1) In support of this rejection, the Examiner construed the projection 80 as a "cover." Applicants submit that this construction is erroneous since: (i) Brown has positively identified the depending structure 80 as a projection; (ii) Brown specifically details the function of the projection 80 - - to stabilize and/or secure the base member 26 on a sash (Col. 6, lns. 5-10); and, (iii) the Examiner's construction would radically alter the operation of Brown's latch 20. As shown in FIGS. 2-4 of Brown, the base member 26 has opposed side portions 52, however, the base member 26 lacks a cover. One of ordinary skill in the art recognizes that a hypothetical cover for the base member 26 would interfere with the movement of Brown's bolt 28 since the bolt 28 is slidably received in the bay 50 of the base member 26. Thus, Brown does not disclose or suggest claim 1's requirement of a housing having a cover.

Attorney Docket No. 1247 P 179  
Application No. 09/713,163  
Page 4

As another separate and independent ground for overcoming the Section 102 rejection, Brown does not disclose or suggest independent claim 1's requirement of an actuator sized to be positioned over the entire cover. The Examiner has construed the claimed actuator as both the bolt 28 and the upward projection 78. One of ordinary skill in the art recognizes that this construction runs contrary to Brown's disclosure since the bolt 28 is repeatedly described as a slide member and since the upward projection 78 is described as "a manually engageable upward projection...to facilitate movement" of the bolt 28. (Col. 3, lns. 55-75) (Col. 6, lns. 1-5). Also, the Examiner has construed the nose 34 of the bolt 28 as the entire latch bolt despite the fact that the structure and function of the nose 34 is repeatedly described in Brown. (Col. 3, lns. 65-75) (Col. 4, lns. 14-17, 40-41). When Brown is properly construed, it is apparent that the actuator 78 is not sized to be positioned over the entire cover, as required by claim 1 because: (i) as explained in the preceding paragraph, the base member 26 lacks a cover; (ii) the actuator 78 only extends from the second end 62 of the bolt 28; and (iii) the actuator 78 is positioned between the side rails 52 of the base member 26, not over any structure of the base member 26. For each of these reasons, Brown fails to disclose or suggest all elements of independent claim 1. Consequently, claim 1 is patentably distinct and is neither anticipated by nor suggested by Brown.

Claims 2, 13, 17-19, and 21 depend from independent claim 1 and thereby require all of the limitations of that claim. For the reasons stated above with respect to claim 1, these claims are patentably distinct and are neither anticipated by nor suggested by Brown.

Claim 3 depends from claim 1 and further requires that the cover have opposed longitudinal peripheral edges and the actuator has opposed depending longitudinal flanges, the flanges being

Attorney Docket No. 1247 P 179

Application No. 09/713,163

Page 5

positioned over the peripheral edges. As explained in the preceding paragraph, the Examiner has misconstrued the depending projection 80 as a cover and the latch bolt 28 as a portion of the actuator, despite Brown's disclosure to the contrary. Since Brown's latch 20 does not have the claimed cover, it cannot have the required longitudinal peripheral edges. Also, Brown's actuator 78 does not have opposed depending longitudinal flanges. As evidence of this, Applicants refer to page 2 of the Office Action where the Examiner does not identify any corresponding structure in Brown and instead referred to the claimed longitudinal flanges with "()". For these reasons and the reasons stated above with respect to claim 1, claim 3 is patentably distinct and is neither anticipated by nor suggested by Brown.

Independent claim 33 is directed to an actuator for a tilt-latch for a sash window and requires, among other things: a housing adapted to be supported by the top rail, the housing having an outward end opening and a cover; a latch bolt disposed within the housing and having a nose adapted for engaging a respective one of the guide rails; and, an actuator having an elongated body connected to the latch bolt and sized to be positioned over the entire cover.

Applicants submit that the Examiner has not established the prima facie case of anticipation because Brown does not disclose each and every element of independent claim 33. Specifically, Brown does not disclose or suggest independent claim 33's requirement of *an actuator having an elongated body connected to the latch bolt and sized to be positioned over the entire cover*. As explained above in the discussion relating to claim 1, the Examiner has misinterpreted Brown's latch 20. Based upon Brown's own written disclosure, one of ordinary skill in the art recognizes that the base member 26 lacks the claimed cover and that the downward projection 80 is not the claimed

Attorney Docket No. 1247 P 179  
Application No. 09/713,163  
Page 6

cover as posited by the Examiner. One of ordinary skill further recognizes that the slide member 28 is the claimed bolt and that it has both a nose 34 and an upwardly extending actuator 78. With this proper interpretation, it is apparent that Brown's slide member 28 and actuator 78 are positioned within the base member 26 and not over a non-existent cover of the base member 26. For these reasons, independent claim 33 is patentably distinct and is neither anticipated by nor suggested by Brown.

Claim 34 depends from independent claim 33 and thereby require all of the limitations of that claim. For the reasons stated above with respect to claim 33, claim 34 is patentably distinct and is neither anticipated by nor suggested by Brown.

Independent claim 47 is directed to a tilt-latch for a sash window disposed within opposed guide rails on a master frame, and requires among other things, a housing adapted to be supported by a top rail of the housing, the housing having an outward end opening and a cover; a latch bolt disposed within the housing and having a nose adapted for engaging a respective one of the guide rails; and, an actuator connected to the latch bolt and sized to be positioned over the entire cover, the actuator having a control button.

For the reasons explained above with respect to independent claim 1, Brown does not disclose or suggest either *a housing having a cover or an actuator sized to be positioned over the entire cover*. Accordingly, independent claim 47 is patentably distinct and is neither anticipated by nor suggested by Brown.

Independent claim 49 is directed to a tilt-latch for a sash window disposed within opposed guide rails on a master frame, and requires among other things, a housing adapted to be supported

Attorney Docket No. 1247 P 179

Application No. 09/713,163

Page 7

by the top rail, the housing having an outward end opening, a cover, and a depending tab adapted for engaging one of the stiles; a latch bolt disposed within the housing and having a nose adapted for engaging a respective one of the guide rails; and, an actuator connected to the latch bolt and sized to be positioned over the entire cover.

For the reasons explained above with respect to independent claim 1, Brown does not disclose or suggest either *a housing having a cover or an actuator sized to be positioned over the entire cover*. Accordingly, independent claim 47 is patentably distinct and is neither anticipated by nor suggested by Brown.

In paragraph three of the Office Action, claims 33 and 34 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,669,639 to Lawrence ("Lawrence"). Applicants respectfully traverse this rejection.

As shown in the exploded view of FIG. 7, Lawrence discloses a latch mechanism 16 having a top section 30, a bolt 20, and a bottom section 31. The bolt 20 is operably supported by the bottom portion 31 with the spring 27 engaging a rear wall of the bottom portion 31. Referring to FIGS. 7-9, the top section 30 has a pair of depending pins 26, 26' that are received by openings 46, 46' in the bottom section 31 to join the top and bottom sections 30, 31. As shown in FIG. 3, the latch mechanism 16 has an crescent-shaped actuator (unlabeled) that extends from the bolt 20 through an opening in the top surface 24 of the top section 30. Similarly and as shown in FIG. 4, the latch mechanism 17 has an hemispherical-shaped actuator (unlabeled) that extends from the bolt 20 through an opening in the top surface 24 of the top section 30.

Attorney Docket No. 1247 P 179  
 Application No. 09/713,163  
 Page 8

Applicants submit that the Examiner has not established the prima facie case of anticipation because Lawrence does not disclose or suggest claim 33's requirement of a tilt-latch with *an actuator having an elongated body connected to the latch bolt and sized to be positioned over the entire cover*. On page 3 of the Office Action, the Examiner construed the top section 30 as the claimed elongated body and stated that it was "...connected to the latch bolt" without explaining how that connection was made. Explaining the basis of the connection of top section 30 to the latch bolt 20 became necessary when Applicants, in their Reply to the May 30, 2002 Office Action, thoroughly explained how the Examiner's interpretation of Lawrence was flawed. Again, the Examiner's interpretation of Lawrence is erroneous and leads to an improper anticipation rejection for at least the following reasons: First, and as shown in Fig. 7, the top section 30 has two depending pins 26 that are received by corresponding holes in the bottom section 31 (see FIG. 9) to secure the top section 30 to the bottom section 31 -- not the bolt 20. One of ordinary skill in the art recognizes that if the top section 30 was connected to the bolt 20 in the manner contemplated by the Examiner, movement of bolt 20 would be precluded, thus negating a key aspect of the latch 16. In the simplest of terms, the Examiner's interpretation of Lawrence would prevent the latch 16 from functioning as intended.

Second, within the text supporting the rejection the Examiner has not identified any structure in Lawrence's latch 16 that corresponds to the claimed cover of the housing. Because the Examiner bears the burden of showing every element of the claimed invention in Brown, the prima facie case of anticipation has not been established. *Ex Parte Skinner*, 2 USPQ.2d 1788 (BPAI 1986). In the event that the Examiner re-construes the top section 30 as the claimed cover, the crescent-shaped



Attorney Docket No. 1247 P 179  
Application No. 09/713,163  
Page 9

actuator of FIG. 3 and the hemispherical-shaped actuator of FIG. 4 are not sized to be positioned over the top section 30. In fact, the aforementioned actuators are relatively small structures that merely extend through an opening in the top section or cover 30.

Based on the foregoing reasons, Lawrence does not disclose or suggest a tilt-latch having an actuator connected to the latch bolt and sized to be positioned over the entire cover. Accordingly, independent claim 33 is patentably distinct and is neither anticipated by nor suggested by Lawrence.

Claim 34 depends from independent claim 33 and thereby require all of the limitations of that claim. For the reasons stated above with respect to claim 33, claim 34 is patentably distinct and is neither anticipated by nor suggested by Lawrence.

#### CLAIM REJECTIONS - 35 U.S.C. §103

In paragraph five of the Office Action, claims 15, 16, and 38 were rejected under 35 U.S.C. §103 as being unpatentable over Brown in view of Lawrence. Applicants respectfully traverse this rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all of the claim limitations. The examiner bears the initial burden on factually supporting any prima facie conclusion of obviousness. See MPEP § 2142. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the Appellant's

Attorney Docket No. 1247 P 179  
 Application No. 09/713,163  
 Page 10

invention itself. See *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79 (Fed. Cir. 1988)); *In re Geiger*, 815 F.2d 686, 687 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147 (Fed. Cir. 1985).

Applicants submit that the Examiner has failed to establish a prima facie case of obviousness because there is no showing of a suggestion or motivation to combine Brown and Lawrence. On page 4 of the Final Office Action, the Examiner stated that "it would have been obvious to one having ordinary skill in the art..." to combine elements of Lawrence with elements of Brown. The well-settled case law requires that the suggestion or motivation to combine the references must be found in the references themselves, and that it is improper to rely on the level of skill in the art to combine the cited references. See MPEP 2143.01; *Al-Site Corp. v. VSI Int'l. Inc.*, 174 F.3d 1308, 50 U.S.P.Q. 2D 1161 (Fed. Cir. 1999). Nowhere in the comments relating to the Section 103 rejection does the Examiner identify a suggestion or motivation from either Brown or Lawrence to combine the references. In addition, the mere fact that Brown and Lawrence may be modified in the manner proposed by the Examiner "...does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gormyan*, 933 F.2d 900, 902 (Fed. Cir. 1984)). Absent the required showing of a suggestion or a motivation to combine Brown and Lawrence, the Examiner's prima facie case of obviousness fails with respect to claims 15, 16, and 38.

As another separate and independent ground for reversing the Section 103 rejection, Applicants submit that the combination of Brown and Lawrence fails to suggest all of the limitations of claim 1, from which claims 15 and 16 depend. As explained above in the Section 102 analysis

Attorney Docket No. 1247 P 179  
Application No. 09/713,163  
Page 11

(see page 4), one of ordinary skill in the art recognizes that Brown does not disclose or suggest an actuator sized to be positioned over the entire cover of the housing. As also explained above (see page 8), Lawrence does not disclose or suggest an actuator sized to be positioned over the entire cover of the housing. Accordingly, the combination of Brown and Lawrence neither discloses nor suggests all of the limitations of claim 15 and 16, and therefore, cannot establish a prima facie case of obviousness. For both of these reasons, claims 15 and 16 are patentably distinct and are not rendered obvious by the combination of Brown and Lawrence.

Claim 38 depends from independent claim 33 and thereby requires all of the limitations of that claim, including the actuator sized to be positioned over the entire cover. For the reasons stated in the preceding paragraphs with respect to claims 15 and 16, claim 38 is patentably distinct and is not rendered obvious by the combination of Brown and Lawrence.

In paragraph six of the Office Action, claim 38 was rejected under 35 U.S.C. §103 as being unpatentable over Lawrence. Applicants respectfully traverse this rejection.

Applicants submit that the Examiner has failed to establish a prima facie case of obviousness because Lawrence fails to suggest all of the limitations of claim 38, from which claim 33 depends. As also explained above (see page 8), Lawrence does not disclose or suggest an actuator sized to be positioned over the entire cover of the housing. Thus, Lawrence does not disclose or suggest all of the limitations of claim 38, and therefore, cannot establish a prima facie case of obviousness. Accordingly, claim 38 is patentably distinct and is not rendered obvious by Lawrence.

Attorney Docket No. 1247 P 179  
Application No. 09/713,163  
Page 12

**CONCLUSION**

In view of the foregoing, Applicants believe the Application is in a condition for allowance, and respectfully request early notice of the same. Applicants request that the Examiner call the undersigned attorney if the Examiner has any questions concerning this Reply, or if it will expedite the progress of this Application.

Respectfully submitted,

Date: 2/27/03

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this document is being facsimile transmitted to Examiner John B. Walsh, Art Unit No. 3676, at the U.S. Patent and Trademark Office on February 27, 2003, to Fax No. 703.872.9326.

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